

REMARKS

Claims 1-13 were pending.

Claims 1-13 stand rejected.

Claim 1 has been amended.

Claims 14-21 have been cancelled, without prejudice.

Claims 22-25 have been added.

Claims 1-13 and 22-25 are currently pending.

I. **REJECTION UNDER 35 U.S.C. § 103**

Claims 1 and 9-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2002/0145999 to Sayeedi et al (“Sayeedi”) and further in view of U.S. Patent Publication No. 2004/01966826 to Bao et al (“Bao”). Applicants note that the Office Action also indicates bases for rejection of Claims 2-8, and that the bases only relate to the Sayeedi reference. Thus, Applicants assume that the 35 U.S.C. § 103 rejection is a rejection of Claims 1-13. Applicants respectfully traverse.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicants to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicants are entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142. In making a rejection, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), *viz.*, (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. In addition to these factual determinations, the examiner must also provide "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (*In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir 2006) (cited with approval in *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)).

The Office Action asserts that Sayeedi discloses all of the recited elements and limitations of Claims 1 and 9-13 except for "identifying a packet application in response to the indicia." Office Action, at 2-3. This missing element is allegedly disclosed by Bao. Id. Applicants respectfully submit that Bao does not disclose identifying a packet application in response to an indicia in a message processed in a standardized interface. Bao's system [0036] detects the existence of a voice over data packet application. Even if the detection is assumed to be in response to a indicia, there is no indication in Bao that the indicia that elicits the detection is in a message being processed in a standardized interface. Therefore, even if Sayeedi could be properly combined with Bao, the combined references would still fail to disclose all of the recited elements and limitations of the rejected claims.

Further, Applicants respectfully submit that Sayeedi and Bao cannot be properly combined. Sayeedi's alleged "indicia," according to paragraph [0005], is a "Data Ready to Send (DRS) indicator" that is used in an A10 connection at call origination to transition from a Dormant state to an Active state. If Bao's alleged response was combined with Sayeedi's configuration, the call would not be processed properly and/or the Bao response would be meaningless in the Sayeedi environment. Likewise, if Sayeedi's alleged "indicia" was incorporated into Bao's system, Bao's system would not recognize the indicia and/or Sayeedi's indicia would render Bao's system inoperable for its intended purpose. Thus, Sayeedi and Bao cannot be properly combined.

Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejection of Claims 1-13.

II. NEW CLAIMS

Applicants have added new Claims 22-25. Applicants respectfully submit that no new matter has been added. At a minimum, Applicants respectfully submit that Claims 22-25 are patentable for one or more reasons discussed above.

New Claim 22 recites:

A method of operating a packet network, comprising:

processing a message in a standardized interface, the message including an indicia indicating a packet application to be transported across the interface;

identifying the packet application in response to the indicia;

distinguishing a first type of content in the packet application from a second type of content in the packet application; and

treating the first type of content differently from the second type of content.

Applicants respectfully submit that the cited references fail to disclose, either separately or combined, certain elements and limitations including, but not limited to, a message processed in a standardized interface, "the message including an indicia indicating a packet application to be transported across the interface." As previously indicated, the cited art also fails to disclose "identifying the packet application in response to the indicia." Further, the cited art fails to disclose "distinguishing a first type of content in the packet application from a second type of content in the

packet application" and "treating the first type of content differently from the second type of content."

Applicants further submit that dependent Claims 23-25 are allowable as depending from an allowable base claim. Moreover Claims 23-25 recite additional elements not found in the cited art.

III. CONCLUSION

As a result of the foregoing, Applicants assert that the pending claims are in condition for allowance, and respectfully request an early allowance of such claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@munckcarter.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Nortel Networks Deposit Account No. 14-1315.

Respectfully submitted,

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